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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,972	07/09/2003	Kenneth S. Wales	END907-0511043	1293

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EXAMINER

DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,972

Applicant(s)

WALES, KENNETH S.

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 7-10, 12 and 14 is/are allowed.
6) ☒ Claim(s) 1-6, 13 and 15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-6 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, on line 3, it is not clear to the examiner where the "articulation motion" is responsive from. On line 4, the examiner cannot find any support in the drawings or the specification for an articulation plane. On line 7, the phrase "lateral motion" lacks antecedent basis. On line 8, it is not clear to the examiner what the phrase "intuitively" encompasses. Furthermore, the phrase "direction of articulation" lacks antecedent basis. In lines 7-9, it is not clear to the examiner what new limitations are being introduced.

In regard to claim 2, on line 3, it is not clear to the examiner where the "articulation motion" is responsive from.

In regard to claim 15, on line 7, the examiner cannot find any support in the drawings or the specification for a plane formed by the movement of the end effector.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milliman et al (US 6,241,139) in view of Bolanos et al (US 5,575,799).

Milliman discloses the invention substantially as claimed including a surgical instrument 10, handle 22, shaft 14, which contains the firing, articulation and rotation mechanisms, anvil 20, a firing device, with cutting blade 280, which travels in channel 282, end effector 17, and articulation mechanism 120 comprised of actuation lever 30, which causes articulation of the end effector as it is moved (see Figs. 1,4,9,10 and C9,L22-29). What Milliman does not disclose is the use of a lateral moving member to articulate the end effector. However, Bolanos teaches that it is old and well known in the art of surgical tools to provide an actuation member 113, which when movingly rotated in a lateral direction articulates the end effector 107 for the purpose of allowing the user to efficiently work at different angles (see Figs. 1,2,5 and C5,L30-43). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Milliman with the articulation means as taught by Bolanos for the purpose of allowing the user to efficiently work at different angles.

Allowable Subject Matter

5. Claims 7-10, 12 and 14 are allowed.

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6. Claims 1,2 and 15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

7. Claims 3-6 currently have no cited prior art as a basis for rejection under 35 U.S.C. §§ 102-3.

Response to Arguments

8. Applicant's arguments, filed 9/3/2004, with respect to the § 112 rejection have been fully considered and are persuasive. The rejection has been withdrawn. However, new grounds of rejection under this section have been issued in section 2 of this action above

9. Applicant's amendment to claim 1 has overcome the rejection under § 103.

10. Applicant's arguments filed 9/3/04, against claim 13 have been fully considered but they are not persuasive.

Applicant argues that the references of Milliman and Bolanos do not teach the applicant's invention, since they do teach the articulation in a plane. The examiner disagrees, the cited art used as the basis for rejection reads on the claimed limitations. Furthermore, applicant's assertion of articulation of an end effector in a plane is not recited in the claim.

Therefore, for the reasons indicated above, the rejection is deemed proper.

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Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand
November 18, 2004



EUGENE KIM
PRIMARY EXAMINER